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August 31, 2005

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Mark Bourgeois

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8/30/2005

Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE:

Serial no.: 09/925,696
Filing date: 08/09/2001
For: Weigela plant named 'Pink Poppet'
Inventor: Benetka
Atty. Docket no.: PH44
Confirmation no.: 4284
Group Art Unit: 1661
Examiner: Grunberg

This is in response to the Notice of Appeal filed on August 13, 2005.

The Commissioner is hereby authorized to charge payment of the \$250.00 small entity appeal brief fee and any other required fee associated with this communication or credit any overpayment to Deposit Account No. 50-2485.

The appeal brief is enclosed with this communication.

Respectfully submitted,

Mark P. Bourgeois
Reg. No. 37,782



APPEAL BRIEF

Real Party in interest

The real party in interest in the present appeal brief is Plantipp.

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

Claim 1 is pending. Claim 1 was finally rejected under 35 U.S.C. 102b as being anticipated by Plant Breeders Rights Documents AU PBR 1998014, granted 9/13/1999 as grant number 1325 and CZ PBR 0WEI06556, granted 5/31/1996 as grant number 679 in view of 'Pink Poppet' being sold in the Czech Republic in 1995. The final rejection of claim 1 is being appealed.

Status of Amendments

There are no amendments that have not been entered.

Summary of claimed subject matter

The invention is a Weigela plant named 'Pink Poppet'. The invention is exemplified in claim 1, which recites the new and distinct variety of Weigela plant named 'Pink Poppet' as described and illustrated.

Support for this is found in the specification on pages 3-5 and is shown in the photographs on sheet 1 and 2.

Grounds of rejection to be reviewed upon appeal

Issue 1 - Whether claim 1 is patentable under 35 USC 102 over Plant Breeders Rights Documents AU PBR 1998014, granted 9/13/1999 as grant number 1325 and CZ PBR 0WEI06556, granted 5/31/1996 as grant number 679 in view of 'Pink Poppet' being sold in the Czech Republic in 1995.

For each ground of rejection, which appellant contests herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

Argument

Issue 1 - Whether claim 1 is patentable under 35 USC 102 over Plant Breeders Rights Documents AU PBR 1998014, granted 9/13/1999 as grant number 1325 and CZ PBR 0WEI06556, granted 5/31/1996 as grant number 679 in view of 'Pink Poppet' being sold in the Czech Republic in 1995.

Independent claim 1 recites a new and distinct variety of Weigela plant named 'Pink Poppet' as described and illustrated.

The Examiner has noted that the variety that is the subject of this application has previously been protected by a plant breeder's rights certificate in one or more foreign countries. The Examiner further noted that the referenced plant breeder's rights certificate was published more than one year prior to the filing date of this plant patent

application in the United States.

The Examiner has used 37 CFR 1.105 to request information from the Applicant regarding whether the variety was publicly available anywhere in the world prior to the filing date of the present application. The Examiner cites *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (BPAI 1992) as authority for this request for information.

Even though the invention was published and on sale in the Czech Republic, the invention has not been enabled in the United States.

The examination strategy set forth by the Examiner results in a denial of plant patent protection in the United States based upon prior art which does not make the plant variety available or accessible to the American public, and frustrates the intent of U.S. patent law. It is the Applicant's belief that the Federal Circuit will not support any rejection based on such an examination policy.

The Examiner cites *Ex parte Thomson*, 24 USPQ 2d 1618, 1620 (BPAI 1992) to support the contention that a printed publication describing a new asexually reproducible plant variety, combined with the availability of the variety anywhere in the world, is sufficient to bar "plant patentability" of the variety under 35 U.S.C. 102(b).

The *Ex Parte Thomson* board admits that the printed publications cited were not, in and of themselves, enabling, and attempts to make those references enabling by combining them with the public availability of the cotton seeds in Australia. A non-enabling printed publication by itself cannot be cited as prior art under 102(b). Foreign public use alone cannot be cited as prior art under 102(b). *Ex Parte Thomson* combined these two non-prior art references.

Plant Breeders Rights Document AU PBR 1998014, granted 9/13/1999 as grant number 1325 was granted with the name 'Plangen'. Plant Breeders Rights Document CZ PBR 0WEI06556, granted 5/31/1996 as grant number 679 was granted with the name 'Piccolo'.

Weigela 'Pink Poppet' was sold in the Czech Republic under the name 'Piccolo'.

Weigela 'Pink Poppet', 'Piccolo' and 'Plangen' are all the same plant sold under different trade names in different countries.

The mere existence of plant material does not enable the invention.

In order to enable the invention, the plant material must be readily available to one skilled in the art (In Re Elsner, 24 USPQ 2d 1618, 1620 (CAFC 2004)).

It is doubtful that one skilled in the art who is interested in reproducing 'Pink Poppet' would know to go to a foreign country and purchase plants under a different name in order to replicate the plant.

A plant breeder reading the Plant Breeders Rights grant for 'Plangen' would not know to go and purchase plants of 'Piccolo' in the Czech Republic.

The sale of 'Piccolo' in the Czech Republic does not enable the invention in the United States.

If an invention has been in widespread public use in France for the last 30 years, but is not the subject of any printed publication, then the original inventor has every right to file for and obtain patent protection in the United States. Section 102(b) expressly allows such a result. The foreign use of the invention is not deemed to have made the invention available to the American public. It is immaterial to any 102(b) analysis that the French public may have had the invention for the last 30 years.

How does the American public get access to a plant invention? In order for the American public to access, use and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be reproduced.

Foreign asexually propagatable plant material, unlike the information in a printed publication, is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States. The quarantine act imposes rigorous importation requirements.

The unique and very narrow scope of protection offered by a plant patent has a direct impact on the scope of prior art that can be properly considered in determining the patentability of a new plant variety. Because a plant patent cannot be infringed without access to the new plant or its asexual progeny, a new plant variety cannot be anticipated without direct access by the American public in the United States to the new plant or its asexually reproduced progeny.

In the case of a plant patent, propagatable material of the new variety is not only essential to enable the invention. It is the invention. In the absence of propagatable material, the variety does not exist, nor can it be conjured up from the description in any printed publication, regardless of how detailed or specific. In the absence of any publicly available asexually propagatable plant material in the United States, no plant variety can, at the present level of technology, be anticipated by a mere printed publication, regardless of how detailed it is, and regardless of where it is published.

For the foregoing reasons, the Applicant asserts that the cited Plant Breeder's Rights Certificates are not a bar to patentability of the claimed new variety under 35

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U.S.C. 102(b), because propagatable material of the variety was not readily available in the United States.

For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark P. Bourgeois', with a stylized flourish at the end.

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Appendix

The claims involved in the appeal follow below:

1. A new and distinct variety of Weigela plant named 'Pink Poppet' as described and illustrated.